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EXAMINER

WEST, JEFFREY R

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2857

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Response to Reply Brief**

1. The reply brief filed October 07, 2005, has been entered and considered. The application has been forwarded to the Board of Patent Appeals and Interferences for decision on the appeal.

2. The Following arguments are also noted:

Appellant first argues:

"In the Examiner's Answer, the Examiner cited *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992) as supporting the obviousness rejection based on the asserted combination of Slutz and Fujimori. Examiner's Answer at 18. *In re Oetiker* clearly does not support the Examiner's position. *In re Oetiker* expressly held that there 'must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the art would make the combination.' *In re Oetiker*, 977 F.2d at 1446. 'The combination of elements from nonanalogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness.' *Id.* In *In re Oetiker*, the court held that the PTO Board failed to establish that a person of ordinary skill in the art would seek to solve a problem of fastening a *hose clamp* with fasteners for *garments*. *Id.* Analogously, the Examiner in this case has failed to establish that a person of ordinary skill in the art looking to perform first and second tests in first and second test systems would look to a reference (Fujimori) that relates to assigning file names for storing musical information."

The Examiner asserts that Appellant continues to indicate that there is no motivation to combine the reference of Slutz and Fujimori without specifically indicating why the proposed motivation is insufficient. In the Examiner's Answer, the Examiner provided motivation recognized by one having ordinary skill in the art as well as motivation from the Slutz and Fujimori references, specifically:

"the inventions of Slutz and Fujimori are properly combined since Slutz does teach including a user-defined parameter in the configuration file specifically indicating the database to be tested (column 5, lines 33-37, "Block 311 reads in a

configuration file 400 containing a set of parameters for the test procedure. One of the parameters specifies the name of a database 260 to provide the data tables”), and combining the filename forming method of Fujimori would have provided a simplified method for finding a specific configuration file desired and increased the speed of finding the file by eliminating the need to implement the time-consuming process of reading the data included in the file and instead allowed the unit to search only the filenames themselves. This combination is further suggested by Fujimori by indicating that the specific file name forming method would provide an indication as to the content of the file just by reading the file name itself making it easier to search for a desired file (column 2, lines 5-10 and 22-26, “Further, the file name must be given with some meaning representing the contents of the waveform data in order to presume the contents of the waveform data form the file name” and “Accordingly, it is a primary object of the present invention to provide an electronic musical instrument which is capable of automatically creating a character string representing the property of the musical tone information such as the sampling waveform data”) and reduce the chance of overwriting a generic file by producing files specific for an intended purpose (column 1, line 66 to column 2, line 5, “Moreover, when assisting the file name to the waveform data, there is a possibility in that the file name previous used is assigned to the waveform data to be currently registered by mistake. In such case, new waveform data are overwritten on the file in which another waveform data have already been written, resulting that those waveform data are destroyed by the new waveform data”).

The Examiner therefore maintains that, without a persuasive argument by Appellant pointing out the flaws in the motivation provided, one having ordinary skill in the art would recognize above-mentioned motivation.

The Examiner also maintains that in *In re Oetiker*, it was decided that arguments presented by the examiner were not supported by references themselves. In this case, the primary reference of Slutz lends to the combination since Slutz already discloses a user-defined parameter in the configuration file specifically indicating the database to be tested. Further, the secondary reference of Fujimori lends to the combination by indicating that the specific file name forming method would provide an indication as to the content of the file just by reading the file name itself making it

easier to search for a desired file and reduce the chance of overwriting a generic file by producing files specific for an intended purpose.

The Examiner also asserts, that in reference to the reliance upon *In re Oetiker*, in the Appeal Brief, Appellant argues that there is no motivation to combine the references of Slutz and Fujimori but then presents arguments explaining that the references are directed to divergent subject matter without pointing out why the suggested motivation is insufficient, specifically:

“The reliance of Fujimori as suggesting a modification of Slutz to achieve the claimed invention is misplaced. Fujimori relates to an electronic musical instrument having a memory for storing musical tone information containing waveform data and assigning a file name to the file that stores the waveform data. Fujimori, Abstract. As discussed in column 5 of Fujimori, character strings can be entered to form a file name. However, Applicant notes that Fujimori has nothing to do with identifying a file name of a data file to use in *first and second tests* based on plural parameters. All Fujimori would have suggested to a person of ordinary skill is a technique for assigning a file name for storing musical tone information. Such a person of ordinary skill in the art would not have been motivated by the teaching of Fujimori to identify a file name of a data file to use, by first and second test systems, in first and second tests based on plural parameters.”

“There was absolutely no suggestion whatsoever of any desirability of incorporating a file name combination technique for musical data, as taught by Fujimori, into the database test environment of Slutz. The Examiner stated that Fujimori was cited only to teach combining two strings/parameters to form a file name. However, the actual teachings of Fujimori cannot be ignored to ascertain whether a person of ordinary skill in the art would have been motivated to combine the teachings of Slutz and Fujimori. Here, the Examiner ignored the actual teachings of Fujimori in arguing that Slutz and Fujimori can be combined to achieve the claimed invention. That is clearly not the case. A person of ordinary skill in the art looking to the teachings of Slutz and Fujimori would clearly not have been led to the claimed invention. Therefore, because no motivation or suggestion existed to combine Fujimori and Slutz, a *prima facie* case of obviousness with respect to claim 1 has not been established for this further reason.”

The Examiner maintains that such arguments that the subject matter of Fujimori is different than that of the invention of Slutz corresponds to an argument that the two references cannot be combined due to being non-analogous.

The Examiner also maintains that *In re Oetiker*, while holding that there must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the art would make the combination, also holds that "In order to rely on a reference as a basis for rejection of the applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned" (*In re Oetiker* at 1445). It is this section of *In re Oetiker* that the Examiner relies upon in response to Appellant's arguments against the proposed combination of Slutz and Fujimori with reference to the arguments that "There was absolutely no suggestion whatsoever of any desirability of incorporating a file name combination technique for musical data, as taught by Fujimori, into the database test environment of Slutz." As such, the Examiner asserts that since the inventions of Slutz and Fujimori are both reasonably pertinent to the particular problem of filename searching and management, in addition to the previously presented motivation, the combination is proper.

The Examiner further asserts that the Examiner is not ignoring the actual teachings of Fujimori, but that the invention of Fujimori is not as concerned to the "musical instrument" aspect as it is the "filename creation" aspect (i.e. see the

Abstract and Summary of Fujimori which focus on the aspect of creating a filename based on specific information regarding the data stored in the file).

Appellant then argues:

“Moreover, as explained in the Appeal Brief, the Examiner has also mischaracterized the teachings of Slutz in rejecting claim 1 over the asserted combination of Slutz and Fujimori. Slutz fails to disclose or suggest at least the following element of claim 1: the first and second test systems using the first data file in performing respective first and second tests. As noted in the Appeal Brief, the teachings of Slutz require that different configuration files have to be used to performed different tests. The configuration file 400 described in Slutz specifies the name of a database 260. Slutz, 5:33-35. This testing process of Slutz is not limited to one or more fixed databases for testing a database system, but rather can employ arbitrary, user-selected target databases. Slutz, 5:35-37. To select different databases, different configuration files (containing different references to databases) would have to be used. As further noted by Slutz, ‘particular features and statement characteristics that produce problems can be emphasized merely by changing a few parameters in the file.’ Slutz, 8:8-11. This is an indication that the parameters of the configuration file 400 are changed for different tests, which indicates that different configuration files are used.”

The Examiner agrees with Appellant’s indication that the configuration file is specific to a particular database being tested, since this is part of the motivation to include Fujimori’s teachings of filename generation specific to the information contained in the file. The Examiner disagrees, however, that Slutz indicates that the configuration file can only be used for one test. The passage relied upon by Appellant states that ‘particular features and statement characteristics that produce problems can be emphasized merely by changing a few parameters in the file” and does not state that the configuration file must be changed to perform different tests, but only indicates that the configuration file can be modified.

As noted in the Examiner's Answer, Slutz further indicates that "Briefly, the invention achieves these and other objectives by reading configuration data containing a set of test parameters; reading the schema of an arbitrary database, then constructing a number of test statements that are syntactically correct for the DBMS being tested, that are semantically compatible with the target database, and that have content and characteristics pursuant to the configuration data" (column 2, lines 52-59).

This passage of Slutz discloses that the specific test statements used are determined based on the configuration file, but does not state that the configuration file contains the test statements or that the configuration file contains test statements that can only be used to perform one test. Therefore, Slutz does not suggest that the same configuration file will result in the same test being performed in multiple client PC's but instead indicates that each of multiple PC's reads in the configuration file and based on the parameters present in the configuration file, generates test statements for performing a distinct test in each of the multiple PC's.

Further, while as noted above the invention of Slutz does not indicate that the same configuration file would result in the same test being performed at each client PC, the disclosure of Slutz is comparable to the method disclosed in the instant invention which states "For a test performed by each test system 12, 14, one or more data files are used. The data files contain data that are used for performing data-driven tests on the database 18 or 20. In accordance with some embodiments, a common set of data files 24 are shared by the different tests systems 12, 14. . . By

receiving certain parameters, a data source routine 124 is able to identify the name of a data file to use. If in each test system the same parameter values are received, then the data source routine 124 will provide the same file name for identifying the data file to use in each test" (page 2, line 30 to page 3, line 11). Therefore, the instant invention also provides two separate testing systems (comparable to the multiple PC's of Slutz) that execute tests based on the same received file.

Appellant then argues:

"As noted in the Appeal Brief, the character strings FNB1 and FNB2 taught by Fujimori do not represent a database, as recited in claim 5. Therefore, the hypothetical combination of Slutz and Fujimori would not teach or suggest identifying a file name of a first data file to use in each of the first and second tests based on plural parameters (where one of the parameters represents a database). Such parameters are clearly not taught by Slutz, nor are they taught by Fujimori. Therefore, the hypothetical combination of Slutz and Fujimori cannot satisfy the subject matter of claim 5. This point was conceded by the Examiner in the Examiner's Answer. Examiner's Answer at 19 ("The examiner maintains that the features of claim 5 are not met by the inventions of Slutz or Fujimori *individually*, but instead are met by the combination of Slutz and Fujimori") (emphasis added). Appellant agrees with the Examiner that the features of claim 5 are not taught by either Slutz or Fujimori - however, Appellant does not agree that the combination of Slutz and Fujimori somehow teaches or suggests an element that is taught in neither reference."

The Examiner asserts that MPEP §2143.03, in setting out the basic requirements of a prima facie case of obviousness, indicates that "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)."

This section does not require that the claimed limitations need to be taught by the references individually, but allows for the limitations to be taught by a combination as long as all of the claim limitations are considered and met by the combination. As such, the invention of claim 5 is not met by the inventions of Slutz and Fujimori individually but by the combination of Slutz and Fujimori.

As described in the Final Office Action and Examiner's Answer, and as noted by Appellant in the Reply Brief, Slutz does teach including a user-defined parameter in the configuration file specifically indicating the database to be tested (column 5, lines 33-37, "Block 311 reads in a configuration file 400 containing a set of parameters for the test procedure. One of the parameters specifies the name of the database 260 to provide the data tables 261") but Slutz does not teach combining two strings/parameters to form a filename of the configuration file. Fujimori teaches an electronic musical instrument having memory for storing tone waveforms and its file name including a control unit and associated routines (column 4, lines 6-15 and column 5, line 13) for receiving a string of characters indicating part of a filename (column 5, lines 49-59), which are manually inputted by a user (column 6, lines 15-19). Fujimori also teaches executing a routine for combining the first string of characters with a second string of characters, formed by a software module, to form a file name (column 7, lines 39-50).

Therefore, since the invention of Slutz already teaches forming a configuration file specific to a particular database under test by including a name of the database under test, modifying the invention of Slutz to include combining user defined strings

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to form the filename, as taught by Fujimori, results in combining the name of the database under test, as taught by Slutz, with a second common parameter indicating to reference the specific configuration file. Further, one having ordinary skill in the art would recognize that this combination would have provided a simplified method for finding a specific configuration file desired and increased the speed of finding the file by eliminating the need to implement the time-consuming process of reading the data included in the filename and instead allowed the unit to search only the filenames themselves. Fujimori further supports this reasoning by indicating that the specific file name forming method would provide indication as to the content of the file just by reading the file name itself making it easier to search for a desired file (column 2, lines 5-10 and 22-26) and reduce the chance of overwriting a generic file by producing files specific for an intended purpose (column 1, line 66 to column 2, line 5).

Appellant argues:

"With respect to the claims of Group 5, the Examiner continues to engage in piecemeal identification of unrelated elements of prior art references to combine elements to achieve the claimed subject matter. As noted in the Appeal Brief, Talley does not disclose searching a predetermined directory on a device to find a test file containing a string that is concatenated from received first and second parameters. Talley describes operations that look for a *configuration file* and determines if the configuration file exists in the user's home directory. Talley, 6:18-23. However, looking for the configuration file of Talley is not the same as searching a directory to find a test file, as recited in the claims. The Examiner argued that "Talley's teaching of searching predetermined storage locations and directories for finding and retrieving the configuration file . . . does teach searching a predetermined directory to find a test file." Examiner's Answer at 24. This characterization of Talley is clearly erroneous, as the word 'test' is nowhere found in Talley."

The Examiner asserts that the claims of Group 5 are rejected under the combination of Slutz, Fujimori, and Talley and the rejection of these claims needs to be considered in terms of the rejection as a whole, rather than attacking the Talley reference individually. In the combination of Slutz and Fujimori, Slutz discloses a test generator for database management systems comprising performing a first test with a first test system, performing a second test with a second test system, using test modules (column 4, lines 17-40), in each of the first and second test systems identifying a file name of a data/configuration file to use in each of the first and second tests, and using the data/configuration file in performing the respective one of the first and second tests (column 5, lines 31-55).

Therefore, the configuration file of Slutz is clearly set forth to be the test file. Appellant understands this interpretation that the configuration file of Slutz is the test file since the paragraph bridging pages 8 and 9 in the Appeal Brief states, "Alternatively, Slutz mentions that the test program 300 can execute within sever 130, or at any other convenient location. Slutz, 5:3-4. In other words, the discussion in column 5 of Slutz focuses on *one* test program running on *one* system (a PC client, a server or other location). Thus, the teaching that the test program reads in a configuration file 400 in column 5 refers to the reading of a configuration file by *one* test program residing on one system."

Therefore, although the invention of Talley does not specifically use the word "test" since the configuration file of Slutz and Fujimori is taken as a test file, the

addition of Talley to include searching a predetermined directory on a device to find a configuration file meets a limitation for searching a directory to find a test file.

Appellant then argues:

“The Examiner continues to argue that Gartner teaches first and second test systems performing the various tasks based on the fact that Gartner discloses that a plurality of users can access the file system and database system. See Examiner's Answer at 27 (citing column 3, lines 1-2, and column 4, lines 21-23, and 54-59 of Gartner). The plurality of users of Gartner clearly do not *receive* plural parameters, do not *identify* a file name of a first data file to use in first and second tests based on plural parameters, and do not use the first data file in performing respective first and second tests. Therefore, the assertion that the hypothetical combination of Gartner and Fitting teaches or suggests all elements of the claim is erroneous.”

The Examiner first asserts that the claimed invention, as presented in claim 1 for example, states “in each of the first and second test systems, receiving plural parameters”. Therefore, Gartner's teaching of a plurality of systems receiving requests from a user via an application programming interface (column 4, lines 30-39) wherein the user supplies a first value, relating to the filename, and a second value, relating to the name of the server/database system under test, (column 5, lines 41-54), meets this limitation without the users receiving plural parameters, but rather the systems receiving plural parameters from the user.

The Examiner also asserts that Appellant is arguing that simply because the invention of Gartner does not teach all the features of a plurality of users receiving plural parameters, identifying a file name of a first data file to use in first and second

tests based on plural parameters, and using the first data file in performing respective first and second tests, that the entire combination of Gartner and Fitting must be erroneous without considering what the rejection states.

The Examiner maintains that Gartner discloses a method and means for testing the performance of a database system by referencing files external to the database system using multiple file systems wherein the test files are created in the file systems and a control table in the database management system controls access to the test files (column 2, lines 51-59). Gartner discloses implementing the method by receiving requests from a user via an application programming interface (column 4, lines 30-39) wherein the user supplies a first value, relating to the filename, and a second value, relating to the name of the server/database system under test, (column 5, lines 41-54) over a network using searching and management control units and software routines (column 5, lines 19-29). Gartner then discloses searching the corresponding database and returning query results including the server/database and filename references which are then used to identify the relevant data file (column 6, lines 16-26). Gartner also discloses that the system is applicable for a plurality of users accessing the system files for multiple tests concurrently (column 3, lines 1-2 and column 4, lines 21-23 and 54-59) and therefore teaches that described method can be performed at different test systems to execute the tests using the same data files.

Therefore while Gartner does teach searching and obtaining data files based on specific filename parameters, Gartner does not specifically disclose combining first and second parameters to form a filename.

Fitting discloses a quality control system of a manufacturing system comprising a plurality of test systems, each test system including a controller that configures the test equipment according to one of a plurality of routines so that the test systems are able to executive a plurality of different tests (column 5, lines 15-23). Fitting discloses that the test systems send a request, through a communication interface employing an Ethernet network (column 3, lines 4-10), to a storage database, containing a plurality of files, for retrieval of a test file to be used by the test controller, which is part of a test module (Figure 1) executed in performing the corresponding test (column 5, lines 15-19). Fitting discloses that the test system provides first and second parameters, the first parameter being a predetermined string value and the second parameter being a value indicating the data type of the requested file, to a test controller that performs a routine combining the two parameters to form a filename which is sent to the database (column 4, lines 20-39). Fitting then discloses searching the database for a test filename containing the string value and a value corresponding to the second file-type parameter (column 4, lines 53-64).

Therefore, the combination of receiving plural parameters from a user in combination with each other to specify a location and obtain a data file from the location to be used in performing first and second tests, as taught by Gartner, with

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combining the first and second parameters into one string/filename thereby identifying a file name of a data file, as taught by Fujimori, meets the limitations in question of *receiving* plural parameters, *identifying* a file name of a first data file to use in first and second tests based on plural parameters, and using the first data file in performing respective first and second tests

Appellant also argues:

“Moreover, with respect to Appellant's argument that there existed no motivation or suggestion to combine Gartner and Fitting, the Examiner continues to use impermissible hindsight to piece together unrelated elements of Gartner and Fitting to achieve the claimed invention. Examiner's Answer at 29. Gartner relates to a testing method and apparatus for evaluating performance of a database system that includes external file references, whereas Fitting describes a quality control system that uses bi-directional messaging that includes empty files. As noted by *In re Oetiker*, case law relied upon by the Examiner, if the only basis for combining the unrelated references, Gartner and Fitting, is impermissible hindsight, then such combination is improper.”

The Examiner maintains that it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the instant case, the Final Office Action motivation takes into account only knowledge within the level of ordinary skill at the time the invention was made and motivation supplied by the references themselves, specifically:

"[i]t would have been obvious to one having ordinary skill in the art to modify the invention of Gartner to include combining first and second parameters to form a filename, as taught by Fitting, because the invention of Gartner does teach that the first and second parameters are used in combination with each other to specify a location, therefore combining the first and second parameters into one string/filename would have provided a functionally equivalent method for indicating a specific file and location. Further, Fitting suggests that the combination would have increased the speed of the search query, to be substantially real-time, by providing descriptive filenames and therefore eliminating the need for the searching unit to implement the time-consuming process of reading the data included in the filename and instead allowed the unit to search only the filenames themselves (column 1, lines 54-59)."

Therefore, since the motivation does not include knowledge gleaned only from Appellant's disclosure, such a reconstruction is proper.

The Examiner also asserts that both the invention of Gartner and Fitting are drawn to test methods employing a plurality of test systems having access to a directory of shared data files.

Appellant further argues:

"In the Examiner's Answer, the Examiner continues to ignore the fact that Gartner does not disclose or suggest receiving a second value representing a database to perform a test on, where the second value is combined with a first value to generate a file name of a test file to use in the test. Although the cited passage of Gartner made in the Examiner's Answer (Gartner, 2:39-40) refers to the random testing of external file references, that does not change the fact that Gartner teaches that the database system being tested is DBMS 15. The external file reference refers to test files - they are not the databases being tested."

The Examiner maintains that in the invention of Gartner, the DBMS is tested by testing the external file references themselves. Gartner specifically discloses the testing of the external file references, stating, "the invention enables external file

references to be randomly tested in a controlled manner" (column 2, lines 39-40).

The Examiner asserts that in testing a database system, the system is tested by testing the ability of the system to correctly obtain/link reference files. In the invention of Gartner, the "database system 12 includes a conventional database management system (DBMS) 15 that provides views of, and access to, a database kept on one or more database storage devices 16" (column 4, lines 4-7) and, as seen in Figures 1 and 3, the database 16 contains reference to the external file reference. Therefore, the Examiner maintains that while the DBMS is the system being tested, such testing is performed by testing the external file references themselves, as supported by the cited portions of Gartner.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. West whose telephone number is (571)272-2226. The examiner can normally be reached on Monday through Friday, 8:00-4:30.

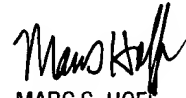
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc S. Hoff can be reached on (571)272-2216. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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jrwl

November 3, 2005



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